

REMARKS

Claims 2-18 are pending in this application.

In paragraphs 2-3 of the Office Action, claims 2-3 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,463,417 (Schoenberg). Applicant respectfully traverses this rejection.

At the outset, Applicant respectfully submits that Schoenberg is not a “patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent,” as required by the statute. The application for patent filed by Schoenberg, U.S. Patent Application No. 09/557, 724, was filed on April 25, 2000, which is after the effective filing date of the invention by the Applicant, which priority has been acknowledged to JP 2000-113971, filed April 14, 2000. Submitted herewith is a certified translation of the priority document.

Further, any reliance on U.S. Provisional Application No. 60/183,857 (the “Provisional”) is statutorily improper, because a patent cannot be granted from a U.S. Provisional Application, and further, the Examiner has not shown that the Provisional provides the 35 U.S.C. § 112, first paragraph disclosure cited in the rejection, as required by 35 U.S.C. § 111(b).

Among the limitations of independent claim 2 that are neither disclosed nor suggested by Schoenberg are the requirements for “providing at least one of the plurality of hospital terminals with the patient user’s medical treatment information from the database using the user ID, the second password, the hospital ID, the hospital password as keys, and storing updated patient user medical treatment information in the database using the user ID, the second password, the hospital ID, and the hospital password as keys.”

Notably, in addition to failing to provide disclosure of these limitations, the Provisional teaches away from the claimed invention. The Provisional advocates “a

methodology that focuses on the ‘need-to-know’ criteria rather than on *requestor identity verification* to secure data transaction.” Provisional, page 5 (emphasis added.) To secure the patient’s data, “the requestor has to provide enough of the *patient’s attributes* that will establish uniqueness,” *i.e.*, that will uniquely identify the patient. Provisional, page 8 (emphasis added). The requestor may also be required to submit “patient constraints, *i.e.* information set by the patient to control access to the data. Provisional, page 9. In other words, the Provisional teaches that a requestor can access the patient’s data if the requestor can uniquely identify the patient, and can supply the patient constraints. The requestor is not required to supply his own user ID or password to authenticate and verify his identity. In contrast, claim 2 requires “hospital ID, and the hospital password as keys” in addition to “user ID [and] the second password” before “providing at least one of the plurality of hospital terminals with the patient user’s medical treatment information from the data base,” or storing updated information to the database. In the absence of any disclosure or suggestion of these features of the claimed invention, independent claim 2 is patentable over the cited prior art.

Dependent claims 3-16 depend from independent claim 2, and incorporate by reference all of the limitations found in the independent claim from which they depend, and are also allowable for the same reasons discussed above. In addition, these dependent claims include further limitations which, in combination with the limitations incorporated by reference, are neither disclosed nor suggested by the prior art of record, and are therefore further allowable.

In paragraph 7 of the Office Action, claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud in view of U.S. Patent No. 4,882,474 Anderl.¹ Applicant traverses.

Among the limitations recited by independent claim 17 that are neither disclosed nor suggested in the prior art of record are the requirements for, “a first computer readable medium

¹ Although the opening sentence identifies Schoenberg in view of Anderl as the basis for the rejection, the body of the rejection cites Mayaud in view of Anderl. Therefore, Applicants consider that Schoenberg has not been used to reject claims 17 and 18.

containing a program that when executed by a processor sends a user password and a second password to a user terminal.” Page 11 of the Office Action admits that Mayaud does not disclose this limitation, but claims that Anderl discloses it. Applicant respectfully disagrees.

Anderl discloses the use of a card containing files with personal information that can be retrieved and modified when combined with software on a workstation and an appropriate password. *See* Anderl, col. 2, ll. 3-9. This functionality is not analogous to “a first computer readable medium that when executed by a processor sends a user password and a second password to a user terminal.” Anderl teaches that a user must enter a password before entering data, which is not the same as a user terminal receiving a password after the execution of a program, as required by claim 17. Therefore, neither Mayaud nor Anderl disclose this claim limitation.

Independent claim 17 also recites, “a second computer readable medium containing a program that when executed by a processor requests the second password when a person other than the user accesses the database containing the information.” Page 11 of the Office Action admits that Mayaud does not disclose this limitation. However, the Office Action argues that Anderl at col. 4, ll. 64-68; col. 5, ll. 1-5 and col. 6, ll. 19-21 discloses this limitation. Applicant respectfully disagrees. Anderl teaches that the system requires “a user to identify himself by means of a password before access to files other than those at the public level is permitted.” Anderl, col. 6, ll. 16-21. In other words, each person accessing the data must supply their own password. In contrast, claim 17 requires that when “a person other than the [patient] accesses the space where the [patient’s] information is stored,” the processor executing the computer program stored on the second computer readable medium “requests the second password,” *i.e.*, the password supplied to the patient, and not a password supplied to the person. Therefore, neither Mayaud nor Anderl disclose this claim limitation.

For at least the foregoing reasons, claim 17 is patentable over Mayaud in view of Anderl. Claim 18 depends from claim 17 and contains further limitations not disclosed or suggested in the prior art. Thus, claim 18 is also patentable over Mayaud in view of Anderl.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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